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3-21-94

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of)
JEAN M. CLEMENT)
on METHOD FOR PRODUCING PULP)
FROM PRINTED UNSELECTED)
WASTE PAPER)
Serial No.: 08/054,951)
Filed: April 27, 1993) (Our Docket No. 2605-01-1-IREI)

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Hartford, Connecticut, March 4, 1994

Hon. Assistant Secretary and Commissioner
of Patents and Trademarks
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

SIR:

In response to the Office Action dated November 4, 1994, applicant submits the following comments. Applicant requests that the Examiner reconsider her rejection of the claims in view of these comments.

The Examiner notes that this reissue application was filed without an offer to surrender the original patent or a declaration that the original patent is either lost or inaccessible. Applicant recognizes this deficiency and will correct it in due course.

Claims 49-52 have been rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period. In particular, the

Examiner argues that the present reissue application is considered not to be timely filed since the parent reissue, SN 600,012, was not a broadening reissue. Although it is not precisely clear, the Examiner also seems to be arguing, at the bottom of page 2 of her Office Action, that the invention described in the claims of the parent reissue is not the same invention disclosed in original U.S. Patent No. 4,780,179 ("the '179 patent").

In response to these arguments, Applicant points out that in the parent reissue claims 1-18 were identical to the claims of the original patent. As to parent reissue claims 19-48, these claims were narrower in several respects than the original claims but were also broader in some respects as compared to the original claims. For example, the numerical limitations regarding temperature, mechanical energy and pH recited in steps (a)-(d) of original claim 1 are eliminated in steps (a)-(d) of parent reissue claim 19.

It is well-settled that where reissue claims are broader in some respects than the claims of the issued patent and narrower in other respects, the reissue application is considered a broadening reissue. Ball v. U.S., 221 USPQ 289, 296 (Fed.Cir. 1984); MPEP 1412.03.

Applicant also points out that the invention described in parent reissue claims 19-48 certainly was disclosed in the '179 patent and that the Examiner's argument to the contrary is not well-taken. The process described in these claims relates not only to removing the non-ink contaminants from the fibers and detaching and dispersing the ink, but also to rendering the fibers and mineral fillers usable for pulp and board making. This aspect of the invention is fully disclosed in the '179 patent at column 7, line 3 to column 8, line 21. Note also, Figure 1, elements 9-13.

Accordingly, since parent reissue application was both a broadening reissue and contained claims describing an invention fully disclosed in the '179 patent, applicant is entitled to rely on the filing date of SN 600,012 for the purposes of filing the present reissue application.

As long as a broadening reissue is filed within the two-year period set forth in § 251, there is nothing which prevents applicant from presenting broadened claims beyond the expiration of this period, even where such claims are broader than the claims of the original patent and the broadening reissue claims originally submitted. Buell v. Beckstrom, 22 USPQ 2d 1128, 1132 (Bd. of Pat. App. and Inter. 1992) (dealing with a division of a reissue application filed almost four years after the issue date of the original patent); In re Doll, 164 USPQ 218, 220 (CCPA 1970); MPEP 1412.03.

The Examiner further argues that the errors set forth by applicant are not errors correctable by reissue, since, according to the Examiner, applicant is attempting to recapture subject matter deliberately narrowed by applicant during the original prosecution in order to obtain the patent.

To support this argument, the Examiner cites Mentor Corp. v. Coloplast, Inc., 27 USPQ 2d 1521 (Fed.Cir. 1993). What the Examiner apparently fails to acknowledge is the Court's statement in this case that:

The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of the claims was not in fact patentable.

Mentor Corp., 27 USPQ 2d at 1524; See also, Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 221 USPQ 568, 574 (Fed. Cir. 1984).

In this regard, it is important to note that during prosecution of the application which matured into the '179 patent claim limitations with respect to temperature, mechanical energy and pH were added in the Preliminary Amendment filed on January 27, 1986 and in the Amendment filed on December

23, 1986. In neither case did the amendments result in an allowance of the claims. Instead, the Examiner steadfastly continued to maintain her rejection of the claims under the Burns reference.

It is absolutely clear from the file history of the '179 patent that, rather than the claim amendments directed to temperature, mechanical energy and pH, the factor that finally resulted in the Examiner issuing a Notice of Allowance was the declaration submitted by Mr. Michael Burns on March 7, 1988. In his declaration, Mr. Burns stated unequivocally that the process disclosed in his paper could not possibly achieve the results obtained by the process disclosed by the applicant.

Thus, in view of the prosecution history of the '179 patent, it cannot be maintained that applicant admitted that claims which do not have limitations directed to the temperature, mechanical energy and pH were not patentable. Accordingly, the recapture rule as interpreted by the Examiner does not apply in this case.

Finally, it appears that the Examiner is taking the position that the specification should be amended to provide antecedent basis for the mechanical energy ranges recited in claims 1 and 50. It is not understood whether or not this is a specific requirement; however, if it is, applicant will comply. The undersigned attorney requests that the Examiner contact the undersigned attorney at the telephone number listed if amendment of the specification is to be a formal requirement.

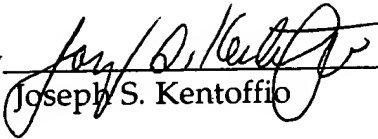
In view of the foregoing, applicant that this reissue application is in condition for allowance and requests that the Examiner reconsider her rejection of the claims.

A check in the amount of \$55.00 is enclosed for a one-month extension of time. Please charge any deficiency in the fees to our Deposit Account No. 13-0235.

Respectfully submitted,

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By


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